

Amendment under 37 CFR 1.114  
Serial No. 10/801,544  
Attorney Docket No. 042187

### **REMARKS**

Claims 1-11 are pending in the present application. Claims 1-3, 7 and 8 are rejected.  
Claims 1, 2, 4, 5 and 7 are herein amended.

### **Applicant's Response to Claim Rejections under 35 U.S.C. §112**

**Claims 2 and 3 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.**

It is the position of the Office Action that it is unclear whether the second and third solutions can be the same, or whether there is a material difference between. Additionally, the Office Action states that it is unclear if the "other biopolymers" also would move into the third solution when, for example, they both have the same size/mass/charge.

In order to clarify the Office Action's reasons for rejecting the claims, Applicant's representative contacted the Examiner on May 23, 2007 to have a brief conversation. The Office Action questioned whether the solutions, or buffers, were the same among the three claimed solutions. Additionally, the Office Action questioned whether the three solutions were truly "partitioned" by the partition, since a gel is inherently porous.

Although the first solution initially contains the target and other biopolymers, the second solution ultimately contains the other biopolymers, and the third solution ultimately contains the target biopolymers, it appears that the actual composition of the solution itself would be the same

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among the first, second and third solutions. Additionally, it appears that the “solution,” presumably a buffer, would permeate the partition, presumably a porous gel.

Accordingly, in response, Applicant herein amends the claims to recite partitioning a container into first, second and third, “buffer chambers.” Such an amendment would modify the claim language such that it is not liquid buffers which are being partitioned from each other, but rather is chambers or regions of a container which are being partitioned from each other. Applicant respectfully submits that such an amendment is sufficient to overcome the rejections based on 35 U.S.C. §112, second paragraph.

Additionally, Office Action states that it is unclear if the “other biopolymers” also would move into the third solution when, for example, they both have the same size/mass/charge. In response, Applicants respectfully clarify the preamble of each of claims 1, 2 and 7 recites a difference in size or charge. Thus, the claims do not encompass such a situation.

**Applicant’s Response to Claim Rejections under 35 U.S.C. §§ 102 and 103**

**Claims 1-3 are rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Serwer et al. (U.S. Patent No. 5,009,759).**

It is the position of the Office Action that Serwer discloses the invention as claimed. Notably, the Office Action states that “[f]or the purposes of examination, the term “solution” has been construed to encompass solution, regardless of viscosity. As such, the term has been construed as encompassing gels used in electrophoresis.” During Applicant’s representative’s

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telephone conversation with the Examiner, the Examiner recommended that the claims recite a "buffer" instead of a "solution." Accordingly, Applicant herein amends the claims in order to recite a "buffer."

Serwer is directed at methods for producing agarose gels having variable pore sizes. In response, Applicant respectfully submits that the rejection based on Serwer is obviated by the claim amendments discussed above. Serwer is only directed at an agarose gel and a method of making an agarose gel. As clarified by the above claim amendments, the present invention is directed at a method of separating biopolymers. Serwer does not disclose or suggest a method in which a container is partitioned into two or three buffer chambers, and the target and other biopolymers are moved as recited, and then separated from the buffer. Accordingly, Applicant respectfully submits that Serwer does not disclose or suggest the invention as claimed in the proposed amended claims. Favorable reconsideration is respectfully requested.

**Claims 7 and 8 were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Velliner et al. (U.S. Patent No. 6,312,910).**

It is the position of the Office Action that Vellinger discloses the invention as claimed. It is the position of the Office Action that Vellinger is directed at a method in which proteins, ligands, chemicals, antigens and other particles are isolated by multistage separation based on magnetic susceptibility and magnetophoretic mobility.

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As explained in Vellinger at column 11, line 40 to column 13, line 67, and illustrated in Figures 9-14, a variety of compounds are present in a lower cuvette 28. Upon application of magnetic force, the particles having magnetic susceptibility are moved into upper cuvette 27, thus isolating the target particles.

In response, Applicant respectfully submits that Vellinger does not disclose the invention as recited by the amended claims. Amended claim 7 requires that a container be partitioned into three buffer chambers. Electrophoresis is utilized in order to move both the target biomolecules and the other biomolecules into the partition. Magnetophoresis is then utilized to move the target biomolecules from the partition into the third buffer chamber. However, Vellinger does not disclose or suggest such a method. Vellinger does not disclose three buffer chambers, and does not disclose or suggest the use of electrophoresis followed by magnetophoresis. Accordingly, Applicant respectfully submits that Vellinger does not disclose or suggest the invention as claimed. Favorable reconsideration is respectfully requested.

#### **Additional Comments**

Applicant notes that this amendment is being filed along with a Request for Continued Examination (RCE). Applicant respectfully requests that the Examiner contact the undersigned for a telephone interview prior to the issuance of the next Office Action, in the event that the Examiner believes that the issues relating to 35 U.S.C. §112 are not resolved.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.


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Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

 C'  
Ryan B. Chirnomas  
Attorney for Applicants  
Registration No. 56,527  
Telephone: (202) 822-1100  
Facsimile: (202) 822-1111

RBC/nrp  
Enclosure: Request for Continued Examination